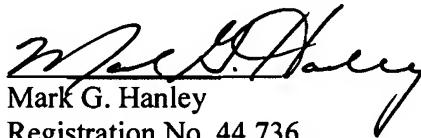




IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Philip E. Bradbury) I hereby certify that this paper is
) being deposited with the United
U.S. Serial	: 10/716,809) States Postal Service with
No.) sufficient postage via express mail
Filed	: 11/19/2003) in an envelope addressed to:
) Commissioner for Patents, P.O.
Title	: METHODS AND) Box 1450, Alexandria, VA 22313-
	APPARATUS FOR) 1450 on this date:
	CUTTING A MOVING)
	MATERIAL)
) August 13, 2007
Art Unit	: 3724)
)
Examiner	: Issac N. Hamilton) 
) Mark G. Hanley
) Registration No. 44,736
) Attorney for Applicant

BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Notice of Appeal received by the United States Patent and Trademark Office on February 5, 2007, in connection with the above-referenced patent application, the applicant respectfully submits this brief on appeal in accordance with 37 C.F.R. 1.192.

I. Real Party In Interest

The above-referenced patent application has been assigned to Bradbury Company, Inc., which is the real party in interest to this appeal. The assignment has been recorded in the United States Patent and Trademark Office ("PTO") at Frame 014939 of Reel 0806.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of the Claims

Currently, claims 17, 22-27, and 55-58 are pending in this application of which claim 17 is independent. The pending claims are presented in Appendix A to this brief. Claims 17, 22-27, and 55-58 stand rejected. Therefore, claims 17, 22-27, and 55-58 form the subject matter of this appeal.

By way of background, this application was filed on November 19, 2003, with claims 1-54. In the first Office action mailed July 21, 2005 (*Paper No. 2*), the examiner required a restriction to one of six patentably distinct groups. The applicant filed a response to the first Office action on September 21, 2005 (*Paper No. 3*). In the response, the applicant elected to prosecute claims 17-27, amended claim 17, and added claims 55-58. *See Paper No. 3*, page 5.

The examiner issued a second Office action on December 19, 2005 (*Paper No. 4*), in which the examiner rejected claims 17-27 and 55-58 under 35 U.S.C. § 102(b) as anticipated by Dotta (U.S. 4,485,713). *See Paper No. 4*, pages 2 and 3. The applicant filed a response to the second Office action on June 19, 2006 (*Paper No. 5*). In the response, the applicant amended claim 17 to incorporate the subject matter of claims 18, 19, and 21 and canceled claims 18-21 without prejudice. *See Paper No. 5*, pages 2 and 5.

The examiner issued a final Office action on September 5, 2006 (*Paper No. 6*), in which the examiner maintained the rejection of claims 17, 22-27, and 55-58 under 35 U.S.C. § 102(b) as anticipated by Dotta. *See Paper No. 6*, page 2. The applicant filed a

response to the final Office action on November 6, 2006 (Paper No. 7), in which the applicant traversed the rejections by way of argument.

The examiner issued an advisory Office action on December 6, 2006 (Paper No. 8), in which the examiner maintained the aforementioned rejections. The applicant filed a notice of appeal and a pre-appeal brief for the Pre-Appeal Brief Conference Pilot Program on February 5, 2007 (Paper No. 9). In the pre-appeal brief, the applicant again traversed the 35 U.S.C. § 102(b) rejections.

The pre-appeal brief panel issued a notice of panel decision from pre-appeal brief review on April 11, 2007 (Paper No. 10), in which the pre-appeal brief panel indicated that at least one actual issue for appeal was found. Accordingly, claims 17, 22-27, and 55-58 stand rejected under 35 U.S.C. § 102(b) forming the subject of this appeal.

IV. Status of the Amendments

No outstanding amendments remain.

V. Summary of the Claimed Subject Matter

Although reference numerals and specification citations are inserted below in accordance with 37 C.F.R. 1.192(c), these reference numerals and specification citations are merely examples of where support may be found in the specification for the terms used in this section of the brief. There is no intention to suggest that the terms of the claims are limited to the examples in the specification. As demonstrated by the reference numerals and specification citations below, the claims are fully supported by the specification as required by law. Nevertheless, it is improper to read limitations from the specification into the claims. Pointing out specification support for the claim terminology, as is done here to comply with 37 C.F.R. 1.192(c), does not limit the scope

of the claims to those examples from which they derive support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In sum, the reference numerals and specification citations are not to be construed as claim limitations nor are they to be used in any way to limit the scope of the claims.

Independent claim 17 is directed to a rotary press apparatus (102) that includes a first ram (114B) rotatably coupled between a first rotating member (110B) and a second rotating member (110D) in an off-center position (203B) relative to a rotational axis of the first and second rotating members (110B and 110D). *See Specification*, Figure 3, ¶ 36. The rotary press apparatus (102) also includes a second ram (114A) rotatably coupled between a third rotating member (110A) and a fourth rotating member (110C) in an off-center position (203A) relative to a rotational axis of the third and fourth rotating members (110A and 110C). *See Id.* The rotary press apparatus (102) also includes a first cutting tool member (208) coupled to the first ram (114B) and a second cutting tool member (206) coupled to the second ram (114A) in a substantially opposing relationship to the first cutting tool member (208). *See Id.*, ¶ 25. The first and second cutting tool members (208 and 206) include a cut-off blade and ram set. *See Id.* The rotary press apparatus (102) also includes a first drive member (112) coupled to the first rotating member (110B) and a second drive member coupled to the second rotating member (110D). *See Id.*, ¶ 24 and 26. The first and second drive members (112) cause the first, second, third, and fourth rotating members (110B, 110D, 110A, and 110C) to rotate causing the first and second rams (114B and 114A) to travel along opposing paths. *See Id.*, ¶ 47.

VI. Grounds of Rejection to be Reviewed on Appeal

The applicant appeals to the Board of Patent Appeals and Interferences to find that Dotta (U.S. 4,485,713) does not anticipate independent claim 17.

VIII. Argument

Dotta does not anticipate independent claim 17 because Dotta does not describe, expressly or inherently, first and second cutting tool members that include a cut-off blade and ram set. In particular, the examiner's construction of the claim language "cut-off blade" is unreasonably broad and inconsistent with its ordinary meaning and the specification of the instant application. Thus, under a proper construction of "cut-off blade," Dotta cannot anticipate claim 17 because it does not describe, expressly or inherently, each and every claimed element.

A. The Examiner's Construction of "Cut-off Blade" is Unreasonably Broad and Inconsistent with its Ordinary Meaning and the Specification of the Instant Application

The examiner's construction of "cut-off blade" is unreasonably broad and inconsistent with its ordinary meaning and the specification of the instant application. During examination, the United States Patent and Trademark Office ("PTO") must give claim terms their broadest reasonable interpretation that is consistent with the specification and one that would be reached by those skilled in the relevant art. *In re Hyatt*, 211 F.3d 1367, 1372 and *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999). In the instant application, claim 17 recites first and second cutting tool members having a cut-off blade and ram set. Under a proper construction, the claim language "cut-off blade" means a flat, elongated structure having an elongated edge to cut-off or shear material.

In determining the meanings of claim terms, extrinsic evidence including descriptions of other patents from analogous arts may properly be consulted to determine the terms' ordinary and customary meanings. *MPEP*, § 2111.01 (III); *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338 (Fed. Cir. 2003); and *In re Cortright*, 165 F.3d at 1358. In *In re Cortright*, the Federal Circuit looked to the description of previously issued patents to reject the PTO's interpretation of a claim term that it construed too broadly. 165 F.3d at 1358. Here, the applicant provides various issued U.S. patents to show that the ordinary and customary meaning of a "cut-off blade" is a flat, elongated structure having an elongated edge to cut-off or shear material. For example, in U.S. patent 4,913,767 (the '767 patent) (Paper No. 11) issued April 3, 1990, U.S. patent 6,367,533 (the '533 patent) (Paper No. 12) issued April 9, 2002, U.S. patent 6,497,263 (the '263 patent) (Paper No. 13) issued December 24, 2002, and U.S. patent 5,125,158 (the '158 patent) (Paper No. 14) issued on June 30, 1992, cut-off blades are shown as flat, elongated structures having an elongated edge to cut off or shear sheet material. In the '767 patent, a cut-off blade (12) is shown as an elongated structure having first and second major surfaces (38 and 39) along the length of the cut-off blade (12) to sever sheet material. *The '767 Patent*, Figures 1 and 3-6 and 3:26-46. In the '533 patent, a cut-off blade assembly (11) has a blade (30) shown as an elongated structure having first and second major surfaces (31 and 32) and a cutting edge (37) along the length of the blade (30) to cut sheet material. *The '533 Patent*, Figures 1-3 and 3:64-4:14. In the '263 patent, a cut-off blade (30) includes first and second major surfaces (31 and 32) and a cutting edge (37) along a length of the cut-off blade (30) to cut sheet material. *The '263 Patent*, Figures 1 and 3-6 and 4:30-49. In the '158 patent, a cutting tool (20) includes a cutting blade (40) to sever work pieces. *The '158 Patent*, 7:18-21. The cutting tool (20) is described in the '158 patent as "flat." *Id.*, 8:54-56. The '158 patent describes

several differently shaped cutting blades (92, 112, 156, 265, 300, 350, and 400) all of which have broad, flat, elongated cutting edges. *Id.*, Figures 7-14.

In U.S. patent 4,826,561 (the '561 patent) (Paper No. 15), a blade is described separately from a punch. The '561 patent describes a shear and punch assembly (28) that has a blade (100 and 100a) and a punch (80 and 80a), which is structurally different than the blade (100 and 100a). *The '561 Patent*, Figures 7-9, 11, and 13-15 and 3:52-55. The blade (100 and 100a) is used to shear a tape (20) and the punch (80 and 80a) is used to punch a hole in a paper sheet (30) and the tape (20). *Id.*, 7:20-25. In the '561 patent, the blade (100 and 100a) has a broad, flat, elongated edge for shearing or cutting off material, while the '561 patent punch (80 and 80a) is a long rod having a punching end, which is structurally different from the flat, elongated structure of the blade (100 and 100a). In view of the above issued U.S. patents, the ordinary meaning of "cut-off blade" is a flat, elongated structure having an elongated edge to cut-off or shear material and is structurally different than a punch.

The specification of the instant application describes a cut-off blade as being able to shear through a sheet material, which is described as a flat, planar material. *See Application*, ¶ 42 and 50. Further, the specification describes a cut-off blade as a structure that is structurally different from a punch. *See Application*, ¶'s 41 and 42. In particular, the specification describes an example implementation in which a cutting tool member (206) implemented using a punch and a cutting tool member (208) implemented using a complementary die are used by a rotary press (102) to punch material (101). *See Id.*, ¶ 41. The applicant also describes another example implementation in which the cutting tool member (206) is implemented using a cut-off blade and the cutting tool member (208) is implemented using a cut-off ram. *See Id.*, ¶ 42. In this example

implementation, the rotary press (102) uses the cut-off blade to shear the material (101). *See Id.* In view of the applicant's separate descriptions of a cut-off blade and a punch, a punch is clearly structurally different than a cut-off blade and, thus, does not constitute a cut-off blade.

Thus, the use of the language "cut-off blade" in the specification is consistent with and supports the ordinary meaning of "cut-off blade" as a flat, elongated structure having an elongated edge to cut off or shear material and is structurally different than a punch.

B. Dotta Does Not Describe Each And Every Claimed Element

Dotta does not describe each and every claimed element. To anticipate a claim, the applied reference must teach each and every claimed element. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987). As discussed above, under a proper construction, a "cut-off blade" is a flat, elongated structure having an elongated edge to cut-off or shear material. Dotta does not describe a flat, elongated structure having an edge to cut-off or shear material. Instead, Dotta describes punches (4), which are thin rods having pointed ends. *Dotta*, 2:40-42 and 3:1-6.

The examiner's apparent position that the language "cut-off blade" encompasses the Dotta punches (4) because they both perform the same function is improper. In an apparatus claim, the recited elements are distinguishable over the prior art based on their structure rather than function such that the prior art may possess every functional aspect of a claimed apparatus but still not anticipate the claim when there is a structural difference. *MPEP*, § 2114; *In re Michlinin*, 256 F.2d 317, 320 (C.C.P.A. 1958); and see *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (a claimed element did not encompass a prior art element even though no "operational difference" found therebetween). In *Hewlett-Packard Co.*, the subject claim recited an

idler wheel having “a random pattern, size, and height of rough spots,” which the Federal Circuit construed to mean “grit.” 909 F.2d at 1467 and 1468. The Federal Circuit rejected the defendant’s argument that a prior art knurled wheel constituted the claimed structure because there was no “operational difference” between the claimed element and the prior art knurled wheel explaining that “apparatus claims cover what a device *is*, not what a device *does*” and that “[a]n invention need not *operate* differently than the prior art to be patentable, but need only *be* different.” *Id.*, at 1468 (emphasis in original).

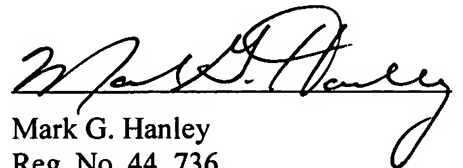
Dotta does not describe or suggest the cut-off blade structure recited in claim 17. The examiner ignores the cut-off blade structural claim element by electing to give effect only to its function of shearing in his contention that the Dotta punches (4) are capable of shearing thin strips of material. *See Paper No. 6*, page 2, § 3 and *Paper No. 8*, page 2 (continuation sheet (PTOL-303)). Specifically, the examiner reasons that the Dotta punches (4) are “capable of shearing off the ends of thin strips of material due to the widths of the [punches (4)].” Assuming, *arguendo*, this is true without further evidence, the Dotta punches (4) do not constitute the specific structural limitation of the cut-off blade recited in claim 17. Even if, after sufficient factual inquiry, one were to find no operational difference between the Dotta punches (4) and the claimed cut-off blade, Dotta cannot anticipate claim 17 without a showing that Dotta teaches the claimed cut-off blade structure. The examiner’s line of reasoning improperly ignores the cut-off blade structural limitation in favor of giving effect only to its function and, thus, has not made a proper showing of how claim 17 is *prima facie* anticipated. Accordingly, Dotta does not teach each and every element of claim 17.

IX. Conclusion

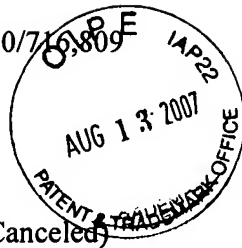
In view of the foregoing, the applicant respectfully submits that Dotta does not anticipate the rejected claims 17, 22-27, and 55-58. Accordingly, the applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102 and respectfully submits that independent claim 17 and all claims dependent thereon are in condition for allowance.

Respectfully submitted,

Dated: 8.13.07



Mark G. Hanley
Reg. No. 44, 736
Attorney for Applicant
Hanley, Flight & Zimmerman, LLC
(at customer number 34431)
150 South Wacker Drive, Suite 2100
Chicago, IL 60606
Tel: (312) 580-1020
Fax: (312) 580-9696



APPENDIX A

1-16 (Canceled)

17. (Previously Presented) A rotary press apparatus comprising:

a first ram rotatably coupled between a first rotating member and a second rotating member in an off-center position relative to a rotational axis of the first and second rotating members;

a second ram rotatably coupled between a third rotating member and a fourth rotating member in an off-center position relative to a rotational axis of the third and fourth rotating members;

a first cutting tool member coupled to the first ram;

a second cutting tool member coupled to the second ram in a substantially opposing relationship to the first cutting tool member, wherein the first and second cutting tool members comprise a cut-off blade and ram set;

a first drive member coupled to the first rotating member; and

a second drive member coupled to the second rotating member, wherein the first and second drive members cause the first, second, third, and fourth rotating members to rotate causing the first and second rams to travel along opposing paths.

Claims 18-21 (Canceled)

22. (Original) An apparatus as defined in claim 17, wherein the first and third rotating members are engaged in a direct drive configuration.

23. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the first ram.

24. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the second ram.

25. (Original) An apparatus as defined in claim 17, wherein the first ram is rotatably coupled to the first rotating member by a rotating bearing.

26. (Original) An apparatus as defined in claim 25, wherein the rotating bearing is rotatably coupled to a stub shaft protruding from the first rotating member.

27. (Original) An apparatus as defined in claim 17, wherein the first rotating member counter-rotates relative to the third rotating member during operation of the apparatus.

28-54 (Canceled)

55. (Previously Presented) An apparatus as defined in claim 17, further comprising a motor coupled to the first and second drive members and configured to drive the first and second drive members.

56. (Previously Presented) An apparatus as defined in claim 17, wherein the first, second, third, and fourth rotating members include spur gears.

57. (Previously Presented) An apparatus as defined in claim 17, wherein the opposing paths are eccentric paths.

58. (Previously Presented) An apparatus as defined in claim 17, wherein the first drive member is engaged to the first rotating member and wherein the second drive member is engaged to the second rotating member.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,809	11/19/2003	Philip E. Bradbury	20015/10004	6765
34431	7590	07/21/2005	EXAMINER	
HANLEY, FLIGHT & ZIMMERMAN, LLC 20 N. WACKER DRIVE SUITE 4220 CHICAGO, IL 60606			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/716,809	Applicant(s) BRADBURY, PHILIP E.	
	Examiner Boyer D. Ashley	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a rotary press apparatus having eccentrically rotating members, classified in class 83, subclass 345.
 - II. Claims 17-27, drawn to a rotary press apparatus having cut-off blades and ram sets, classified in class 83, subclass 669.
 - III. Claims 28-36, drawn to rotary press system having circular rotating paths, classified in class 83, subclass 669.
 - IV. Claims 37-42, drawn to a method for cutting a moving material, classified in class 83, subclass 13.
 - V. Claims 43-48, drawn to a system for producing a product from a moving material, classified in class 83, subclass 667.
 - VI. Claims 49-54, drawn to a method of producing a product from a moving material, classified in class 83, subclass 13.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of groups I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). For example, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can

be used without the cut-off blade and ram set of the subcombination of Group II. The subcombination has separate utility such as it could be used without the eccentric paths of the first and second ram faces as claimed in the combination of group I.

3. Inventions of groups III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). For example, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can be used without punch and die set of Group I. The subcombination has separate utility such as it could be used without the circular paths of Group III.

4. Inventions IV and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). For example, the process as claimed can be practiced by another materially different apparatus such as an apparatus not having the specific third and fourth rotating members.

5. Inventions of groups V and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). For example, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can be used without the first and second guides being linear guides as claimed in the subcombination of Group I. The subcombination has separate utility such as it could be used without the continuous use of a shearing rotary press, punching rotary press, and a roll-former unit as claimed in the combination of group V.

6. Inventions VI and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). For example, the process as claimed can be practiced by another materially different apparatus such as an apparatus not having the specific roll forming.

7. The remaining groups can be similar shown as distinct from each other.

8. There is an excessive burden on the office to examine all of these inventions together, as shown by their search. See MPEP 808.02(c). For example, the device of group I will need to be searched class 83, subclass 345, along with a unique text search. Group IV would not be searched as above, but would instead be searched in class 83, subclass 13 accompanied by a different text search. Groups I-VI all have unique searches.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 3724

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



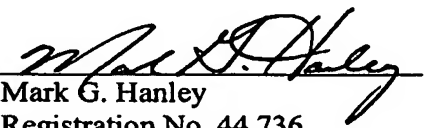
Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
July 18, 2005



PATENT
Attorney Docket No. 20015/10004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Philip E. BRADBURY) I hereby certify that this paper
U.S. Serial No.	: 10/716,809) (and/or fee) is being deposited with
Filed	: 11/19/2003) the United States Postal Service as
Title	: METHODS AND) first class mail in an envelope
	APPARATUS FOR) addressed to: Mail Stop
	CUTTING A MOVING) Amendment, Commissioner for
	MATERIAL) Patents, P.O. Box 1450, Alexandria,
) VA 22313-1450 on this date:
) Dated: September 21, 2005
)
Art Unit	: 3724) 
Examiner	: Boyer Dolinger Ashley) Mark G. Hanley
) Registration No. 44,736
) Attorney for Applicant

RESPONSE TO THE OFFICE ACTION DATED JULY 21, 2005

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Amendments to the claims begin on page 2 of this paper.

Remarks begin on page 5 of this paper.

Amendments to the claims:

1-16 (Canceled)

17. (Currently Amended) A rotary press apparatus comprising:

a first ram rotatably coupled between a first rotating member and a second rotating member in an off-center position relative to a rotational axis of the first and second rotating members; and

a second ram rotatably coupled between a third rotating member and a fourth rotating member in an off-center position relative to a rotational axis of the third and fourth rotating ~~members~~members;

a first drive member coupled to the first rotating member; and

a second drive member coupled to the second rotating member, wherein the first and second drive members cause the first, second, third, and fourth rotating members to rotate causing the first and second rams to travel along opposing paths.

18. (Original) An apparatus as defined in claim 17, wherein a first cutting tool member is coupled to the first ram.

19. (Original) An apparatus as defined in claim 18, wherein a second cutting tool member is coupled to the second ram in a substantially opposing relationship to the first cutting tool member.

20. (Original) An apparatus as defined in claim 19, wherein the first and second cutting tool members comprise a punch and die set.

21. (Original) An apparatus as defined in claim 19, wherein the first and second cutting tool members comprise a cut-off blade and ram set.
22. (Original) An apparatus as defined in claim 17, wherein the first and third rotating members are engaged in a direct drive configuration.
23. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the first ram.
24. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the second ram.
25. (Original) An apparatus as defined in claim 17, wherein the first ram is rotatably coupled to the first rotating member by a rotating bearing.
26. (Original) An apparatus as defined in claim 25, wherein the rotating bearing is rotatably coupled to a stub shaft protruding from the first rotating member.
27. (Original) An apparatus as defined in claim 17, wherein the first rotating member counter-rotates relative to the third rotating member during operation of the apparatus.
- 28-54 (Canceled)

55. (New) An apparatus as defined in claim 17, further comprising a motor coupled to the first and second drive members and configured to drive the first and second drive members.

56. (New) An apparatus as defined in claim 17, wherein the first, second, third, and fourth rotating members include spur gears.

57. (New) An apparatus as defined in claim 17, wherein the opposing paths are eccentric paths.

58. (New) An apparatus as defined in claim 17, wherein the first drive member is engaged to the first rotating member and wherein the second drive member is engaged to the second rotating member.

REMARKS


The applicant has carefully considered the official action dated July 21, 2005. In the official action, the examiner identified six patentably distinct inventions and required restriction of this application to one of those inventions. In particular, the examiner identified six groups of claims as follows: Group I (claims 1-16), Group II (claims 17-27), Group III (claims 28-36), Group IV (claims 37-42), Group V (claims 43-48), and Group VI (claims 49-54).

By way of this response, the applicant hereby elects claims 17-27 for prosecution. Further, the applicant has amended independent claim 17 and added claims 55-58 for consideration. No new matter has been added. Accordingly, claims 17-27 and 55-58 are pending and at issue in this application.

In view of the foregoing, the applicant respectfully requests an early favorable action on the merits. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

Dated: September 21, 2005


Mark G. Hanley
Reg. No. 44,736
Attorney for Applicant
Hanley, Flight & Zimmerman, LLC
(at customer number 34431)
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606
312.580.1020



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,809	11/19/2003	Philip E. Bradbury	20015/10004	6765
34431	7590	12/19/2005	EXAMINER	
HANLEY, FLIGHT & ZIMMERMAN, LLC			HAMILTON, ISAAC N	
20 N. WACKER DRIVE			ART UNIT	
SUITE 4220			PAPER NUMBER	
CHICAGO, IL 60606			3724	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,809

Applicant(s)

BRADBURY, PHILIP

Examiner

Isaac N. Hamilton

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/05/04, 07/18/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II, claims 17-27 and 55-58, in the reply filed on 09/26/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17-27 and 55-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Dotta (4,485,713). Dotta discloses first ram 1; second ram 2; first rotating member 9; second rotating member 109; third rotating member 9; fourth rotating member 109; off-center position located at 7 and 8 in figures 1 and 2; rotational axes juxtaposed elements 10 and 9, and juxtaposed elements 110 and 109; first drive member 11'; second drive member 11; first cutting tool 3; second cutting tool 4; punch and die set 3, 4; cut-off blade and ram set 3, 4; first and third rotating members are in a direct drive configuration as seen in figure 3; guide member 5, 105; rotating bearing located at 7, 8, 107, 108; stub shaft 7; motors are inherently connected to the first and second drive members as indicated at the shafts 11 and 11' that are driving the first and second drive members in figure 3; spur gears in column 2, lines 8-12; eccentric paths in column

Art Unit: 3724

2, lines 17-19; first drive member is engaged to the first rotating member and the second drive member is engaged to the second rotating member in column 2, lines 13-15.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

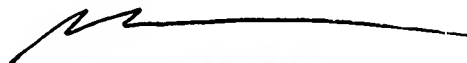
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

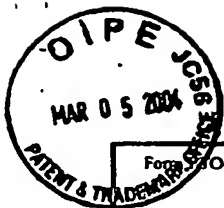
IH

IH

December 12, 2005



KENNETH E. PETERSON
PRIMARY EXAMINER



SHEET 1 of 1

Form O-1449 (Modified)	U.S. Department of Commerce Patent and Trademark Office	Atty. Docket No. 20015/10004	Serial No. 10/716,809
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)		Applicant Philip E. BRADBURY	
		Filing Date 11/19/2003	Group Art Unit 3724

U.S. PATENT DOCUMENTS							
*EXAMINER INITIALS		DOCUMENT NUMBER	ISSUE DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
<i>PH</i>		2,445,174	7/13/1948	HANNEWALD, et al.			
<i>PH</i>		6,205,898	3/27/2001	SURINA	83	76	

FOREIGN PATENT DOCUMENTS							
*Examiner Initials		Document Number	Publication Date	Country	Class	Subclass	Translation Yes No

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)		

EXAMINER <i>[Signature]</i>	DATE CONSIDERED <i>12/11/05</i>
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	



SHEET 1 of 1

Form PTO-1449 (Modified)

U.S. Department of Commerce
Patent and Trademark OfficeAtty. Docket No.
20015/10004Serial No.
10/716,809

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

Applicant

Bradbury

Filing Date

November 19, 2003

Group Art Unit

3724

U.S. PATENT DOCUMENTS

*EXAMINER INITIALS		DOCUMENT NUMBER	ISSUE DATE	INVENTOR(S)	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	A01	4,204,449	5/27/1980	Kersting et al.			
	A02	4,471,641	9/18/1984	Mitchell			
	A03	4,027,517	6/7/1977	Bodnar			
	A04	4,553,418	11/19/1985	Stoeck et al.			
	A05	3,861,260	1/21/1975	Kesten et al.			
	A06	4,485,713	12/4/1984	Dotta			
	A12						
	A13						
	A14						
	A15						

FOREIGN PATENT DOCUMENTS

*Examiner Initials		Document Number	Publication Date	Country	Class	Subclass	Translation	
							Yes	No
	B01	FR 2 537 489	6/15/1984	FR				
	B02	WO 01/08875	2/8/2001	PCT				
	B03	WO 98/19915	5/14/1998	PCT				

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

	C01	European Search Report corresponding to European Application Serial No. EP 04 02 6587, February 22, 2005.
	C02	

EXAMINER

DATE CONSIDERED

12/11/05

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Notice of References Cited	Application/Control No. 10/716,809	Applicant(s)/Patent Under Reexamination BRADBURY, PHILIP	
	Examiner Isaac N. Hamilton	Art Unit 3724	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

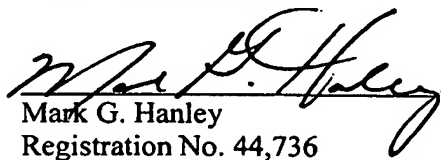
*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



PATENT

Attorney Docket No. 20015/10004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Philip E. BRADBURY) I hereby certify that this paper
U.S. Serial No.	: 10/716,809) (and/or fee) is being deposited with
Filed	: 11/19/2003) the United States Postal Service as
Title	: METHODS AND) first class mail in an envelope
	APPARATUS FOR) addressed to: Mail Stop
	CUTTING A MOVING) Amendment, Commissioner for
	MATERIAL) Patents, P.O. Box 1450, Alexandria,
) VA 22313-1450 on this date:
) Dated: June 19, 2006
Art Unit	: 3724) 
Examiner	: Issac N. Hamilton) Mark G. Hanley
) Registration No. 44,736
) Attorney for Applicant

RESPONSE TO THE OFFICE ACTION DATED DECEMBER 19, 2005

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Amendments to the claims begin on page 2 of this paper.

Remarks begin on page 5 of this paper.

Amendments to the claims:

1-16 (Canceled)

17. (Currently Amended) A rotary press apparatus comprising:

a first ram rotatably coupled between a first rotating member and a second rotating member in an off-center position relative to a rotational axis of the first and second rotating members;

a second ram rotatably coupled between a third rotating member and a fourth rotating member in an off-center position relative to a rotational axis of the third and fourth rotating members;

a first cutting tool member coupled to the first ram;

a second cutting tool member coupled to the second ram in a substantially opposing relationship to the first cutting tool member, wherein the first and second cutting tool members comprise a cut-off blade and ram set;

a first drive member coupled to the first rotating member; and

a second drive member coupled to the second rotating member, wherein the first and second drive members cause the first, second, third, and fourth rotating members to rotate causing the first and second rams to travel along opposing paths.

Claims 18-21 (Canceled)

22. (Original) An apparatus as defined in claim 17, wherein the first and third rotating members are engaged in a direct drive configuration.

23. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the first ram.
24. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the second ram.
25. (Original) An apparatus as defined in claim 17, wherein the first ram is rotatably coupled to the first rotating member by a rotating bearing.
26. (Original) An apparatus as defined in claim 25, wherein the rotating bearing is rotatably coupled to a stub shaft protruding from the first rotating member.
27. (Original) An apparatus as defined in claim 17, wherein the first rotating member counter-rotates relative to the third rotating member during operation of the apparatus.
- 28-54 (Canceled)
55. (Previously Presented) An apparatus as defined in claim 17, further comprising a motor coupled to the first and second drive members and configured to drive the first and second drive members.
56. (Previously Presented) An apparatus as defined in claim 17, wherein the first, second, third, and fourth rotating members include spur gears.

57. (Previously Presented) An apparatus as defined in claim 17, wherein the opposing paths are eccentric paths.

58. (Previously Presented) An apparatus as defined in claim 17, wherein the first drive member is engaged to the first rotating member and wherein the second drive member is engaged to the second rotating member.

REMARKS

The applicant has carefully considered the official action dated December 19, 2005 and the cited references. In this application, claims 17-27 and 55-58 are pending and at issue, of which claim 17 is independent. In the official action, claims 17-27 and 55-58 were rejected under 35 U.S.C. § 102(b) as anticipated by Dotta. The applicant has amended claim 17 to incorporate the limitations of dependent claims 18, 19, and 21 to clarify the scope of protection sought and has canceled claims 18-21 without prejudice. No new matter has been added. By way of this response, the applicant respectfully traverses the rejections and respectfully submits that all pending claims are in condition for allowance. Favorable reconsideration is respectfully requested.

The applicant respectfully submits that independent claim 17 is allowable over the art of record. Independent claim 17 is directed to a rotary press apparatus that includes, *inter alia*, a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. The art of record fails to teach or suggest first and second cutting tool members comprising a cut-off blade and ram set as recited in claim 17. Dotta teaches an upper die (1) having female tools or matrixes (3) and a lower die (2) having male tools or punches (4). However, Dotta does not teach that the upper and lower dies (1) and (2) have or can have a cut-off blade and ram set. Therefore, Dotta cannot anticipate independent claim 17 because Dotta does not teach each and every element recited in independent claim 17.

In addition, the applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the Dotta punching

device to have a cut-off blade and ram set because such a modification would change the principle of operation of the Dotta punching device. The law is quite clear that, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims prima facie obvious.” MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 813 (C.C.P.A. 1959)). In *In re Ratti*, the claims were directed to an oil seal comprising “...a sealing ring ... of resiliently deformable material...” 270 F.2d at 810 (citing *Ratti* application, claim 10). The prior art reference relied upon by the examiner described a “stiffened’ sealing member.” *Id.* at 811 (emphasis in original). The court held that replacing the stiffened sealing member in the prior art reference with a resiliently deformable material was not a proper line of reasoning to support a prima facie rejection because, “[it] would require a substantial reconstruction and redesign of the elements shown in [the prior art reference] as well as a change in the basic principles under which the [prior art reference] construction was designed to operate.” *See Id.* at 813. Accordingly, the court reversed the examiner’s obviousness rejection.

Here, Dotta describes a particular configuration for the punch and matrix tool assemblies (3) and (4) to provide satisfactory operation that is immune to “play” between toothed wheels (9) and (109). *See Dotta*, col. 2, ll. 36-40 (“ensure satisfactory operation of the described device even in case of slight play between the toothed wheels 9 and 109 and tolerances in the construction and mounting of the various parts forming the device”). Dotta teaches mounting the punches (4) in the die (2) for “axial laterally sealed movement” to enable the punches (4) to shift transversely so that the punches (4) and matrixes (3) need not be accurately aligned before starting operation. *See Id.*, col. 2, ll. 40-43. Dotta also teaches providing a water-tight chamber (16) filled with water that interconnects the punches (4) by a

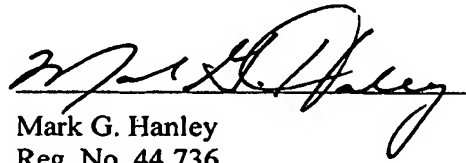
hydrostatic connection. *See Dotta*, col. 2, ll. 46-62. The hydrostatic connection enables the punches (4) of different lengths to adapt their protrusion from the die (2) to operate correctly with the matrixes (3).

Any proposal to modify the Dotta punching device by replacing the punch and matrix tool assemblies (3) and (4) with the cut-off blade and ram set recited in claim 17 would change the principle of operation of the Dotta punching device. For example, replacing the Dotta punches (4) with a cut-off blade would obviate the need for the hydrostatic connection associated with the Dotta punches (4) and, thus, eliminate the hydrostatic connection. Dotta describes the hydrostatic connection as an advantage of the Dotta invention because it enables punches of different lengths to adjust to the matrixes (3) of an opposing die. *See Id.*, col. 2, ll. 58-68 and col. 3, ll. 1-8. The applicant respectfully submits that eliminating the hydrostatic connection would change a principle of operation of the Dotta punching device. Therefore, it would not be *prima facie* obvious to modify the Dotta punching device by replacing the matrix and punch tool assemblies (3) and (4) with the cut-off blade and ram set recited in claim 17. Accordingly, the applicant respectfully submits that independent claim 17 and all claims dependent thereon are in condition for allowance.

In view of the foregoing, the applicant respectfully requests an early favorable action on the merits. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

Dated: **June 19, 2006**


Mark G. Hanley
Reg. No. 44,736
Attorney for Applicant
Hanley, Flight & Zimmerman, LLC
(at customer number **34431**)
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606
312.580.1020



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,809	11/19/2003	Philip E. Bradbury	20015/10004	6765
34431	7590	09/05/2006	EXAMINER	
HANLEY, FLIGHT & ZIMMERMAN, LLC 20 N. WACKER DRIVE SUITE 4220 CHICAGO, IL 60606			HAMILTON, ISAAC N	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,809	Applicant(s) BRADBURY, PHILIP E.	
	Examiner Isaac N. Hamilton	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 22-27 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 22-27 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17, 22-27 and 55-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Dotta (4,485,713). Dotta discloses first ram 1; second ram 2; first rotating member 9; second rotating member 109; third rotating member 9; fourth rotating member 109; off-center position located at 7 and 8 in figures 1 and 2; rotational axes juxtaposed elements 10 and 9, and juxtaposed elements 110 and 109; first drive member 11'; second drive member 11; first cutting tool 3; second cutting tool 4; cut-off blade and ram set 3, 4; first and third rotating members are in a direct drive configuration as seen in figure 3; guide member 5, 105; rotating bearing located at 7, 8, 107, 108; stub shaft 7; motors are inherently connected to the first and second drive members as indicated at the shafts 11 and 11' that are driving the first and second drive members in figure 3; spur gears in column 2, lines 8-12; eccentric paths in column 2, lines 17-19; first drive member is engaged to the first rotating member and the second drive member is engaged to the second rotating member in column 2, lines 13-15.

Response to Arguments

3. Applicant's arguments filed 06/22/06 have been fully considered but they are not persuasive. Applicant asserts that elements 3 and 4 are not a cut-off blade and ram set. However, elements 3 and 4 are capable of shearing off the ends of thin strips of material due to

the widths of elements 3 and 4. It is to be noted that the terms "blade" and "ram" are broad and can be used to describe a punch and a die.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W

IH

August 31, 2006


KENNETH E. PETERSON
PRIMARY EXAMINER

PATENT
Attorney Docket No. 20015/10004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Philip E. BRADBURY)	I hereby certify that this document
)	is being deposited electronically
U.S. Serial No.	:	10/716,809)	with the United States Patent and
)	Trademark Office on this date:
Filed	:	11/19/2003)	
)	November 6, 2006
Title	:	METHODS AND)	
		APPARATUS FOR)	
		CUTTING A MOVING)	____/Mark G. Hanley/_____
		MATERIAL)	Mark G. Hanley
)	Registration No. 44,736
)	Attorney for Applicant
Art Unit	:	3724)	
)	
Examiner	:	Issac N. Hamilton)	
)	

RESPONSE TO THE FINAL OFFICE ACTION DATED AUGUST 5, 2006

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Amendments to the claims begin on page 2 of this paper.

Remarks begin on page 5 of this paper.

Amendments to the claims:

1-16 (Canceled)

17. (Previously Presented) A rotary press apparatus comprising:

a first ram rotatably coupled between a first rotating member and a second rotating member in an off-center position relative to a rotational axis of the first and second rotating members;

a second ram rotatably coupled between a third rotating member and a fourth rotating member in an off-center position relative to a rotational axis of the third and fourth rotating members;

a first cutting tool member coupled to the first ram;

a second cutting tool member coupled to the second ram in a substantially opposing relationship to the first cutting tool member, wherein the first and second cutting tool members comprise a cut-off blade and ram set;

a first drive member coupled to the first rotating member; and

a second drive member coupled to the second rotating member, wherein the first and second drive members cause the first, second, third, and fourth rotating members to rotate causing the first and second rams to travel along opposing paths.

Claims 18-21 (Canceled)

22. (Original) An apparatus as defined in claim 17, wherein the first and third rotating members are engaged in a direct drive configuration.

23. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the first ram.

24. (Original) An apparatus as defined in claim 17, wherein a guide member is mechanically coupled to the second ram.

25. (Original) An apparatus as defined in claim 17, wherein the first ram is rotatably coupled to the first rotating member by a rotating bearing.

26. (Original) An apparatus as defined in claim 25, wherein the rotating bearing is rotatably coupled to a stub shaft protruding from the first rotating member.

27. (Original) An apparatus as defined in claim 17, wherein the first rotating member counter-rotates relative to the third rotating member during operation of the apparatus.

28-54 (Canceled)

55. (Previously Presented) An apparatus as defined in claim 17, further comprising a motor coupled to the first and second drive members and configured to drive the first and second drive members.

56. (Previously Presented) An apparatus as defined in claim 17, wherein the first, second, third, and fourth rotating members include spur gears.

57. (Previously Presented) An apparatus as defined in claim 17, wherein the opposing paths are eccentric paths.

58. (Previously Presented) An apparatus as defined in claim 17, wherein the first drive member is engaged to the first rotating member and wherein the second drive member is engaged to the second rotating member.

REMARKS

The applicant has carefully considered the official action dated September 5, 2006, and the cited references. In this application, claims 17, 22-27, and 55-58 are pending and at issue, of which claim 17 is independent. In the official action, claims 17, 22-27 and 55-58 were rejected under 35 U.S.C. § 102(b) as anticipated by Dotta. By way of this response, the applicant respectfully traverses the rejections and respectfully submits that all pending claims are in condition for allowance. Favorable reconsideration is respectfully requested.

The applicant respectfully submits that independent claim 17 is allowable over the art of record. Independent claim 17 is directed to a rotary press apparatus that includes, *inter alia*, a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. The applicant maintains his position that the art of record fails to teach or suggest first and second cutting tool members comprising a cut-off blade and ram set as recited in claim 17. Dotta teaches an upper die (1) having female tools or matrixes (3) and a lower die (2) having male tools or punches (4). However, Dotta does not teach that the upper and lower dies (1) and (2) have or can have a cut-off blade and ram set. Therefore, Dotta cannot anticipate independent claim 17 because Dotta does not teach each and every element recited in independent claim 17.

The examiner suggests that the matrixes (3) and punches (4) are capable of shearing off the ends of thin strips of material due to their widths, and that the cut-off blade and ram set recited in claim 17 are broad and can be used to describe the matrixes(3) and the punches (4). *See Final Office action dated August 5, 2006*, pp. 2 and 3, ¶ 3. Although the applicant agrees that “cut-off blade” and “ram” are relatively broad terms, the applicant respectfully

submits that the meaning of cut-off blade and ram cannot be construed so broadly as to encompass the matrixes (3) and punches (4) of Dotta. On the contrary, the examiner has adopted an improper and unfairly broad meaning for the term cut-off blade and ram. Namely, the examiner believes that the cut-off blade and ram encompass a punch and die. Further, the examiner's overly broad definition of the cut-off blade and ram contradicts the plain meaning that would be given the terms by one of ordinary skill in the art in light of the applicant's specification. During examination, a claim term should be given the broadest reasonable interpretation that is consistent with the applicant's specification and "should be read in light of the [applicant's] specification as it would be interpreted by one of ordinary skill in the art." *In Re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). The *Cortright* court rejected the interpretation given to a claim term by the examiner and the Board of Patent Appeals and Interferences ("the Board") for being so broad that it was inconsistent with the Cortright specification and overextended the interpretation that it would be given by one of ordinary skill in the art in light of the Cortright specification. *Id.*, at 1359.

The applicant's specification describes a cut-off blade and ram set as being distinctly separate from a punch and die set. *See Applicant's written description*, ¶'s 41 and 42. For example, the applicant describes in the instant application an example embodiment in which a cutting tool member (206) is a punch and a cutting tool member (208) is a complimentary die. *See Id.*, ¶ 41. In addition, the applicant describes another example embodiment in which the cutting tool member (206) is a cut-off blade and the cutting tool member (208) is a cut-off ram. *See Id.*, ¶ 42. In this case, the examiner has impermissibly ignored the applicant's specification and, thus, has improperly divorced his interpretation of cut-off blade and ram set from the context of the applicant's invention.

Further, the examiner has misconstrued the Dotta reference titled, "Punching Device," to be capable of performing operations other than punching. Specifically, the examiner suggests that the Dotta punching device is capable of shearing, but has improperly supported this suggestion by mere opinion on what the Dotta matrixes (3) and punches (4) are capable of doing (due to their alleged widths) without pointing out where Dotta makes such a teaching or suggestion. If the examiner elects to maintain his position that the Dotta punching device is capable of shearing, the applicant respectfully requests that at least some evidence supporting this position be provided.

Therefore, in addition to impermissibly ignoring the applicant's specification as well as what one of ordinary skill in the art would know, the examiner has improperly misconstrued the Dotta reference to arrive at the elements recited in claim 17. Contrary to the examiner's suggestion, the applicant respectfully submits that Dotta does not teach or suggest a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. Accordingly, the applicant respectfully submits that independent claim 17 and all claims dependent thereon are in condition for allowance.

In view of the foregoing, the applicant respectfully requests an early favorable action on the merits. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

Dated: **November 6, 2006**

Hanley, Flight & Zimmerman, LLC
(at customer number **34431**)
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606
312.580.1020

____/Mark G. Hanley/_____

Mark G. Hanley
Reg. No. 44,736
Attorney for Applicant



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,809	11/19/2003	Philip E. Bradbury	20015/10004	6765

34431 7590 12/06/2006

HANLEY, FLIGHT & ZIMMERMAN, LLC
 150 S. WACKER DRIVE
 SUITE 2100
 CHICAGO, IL 60606

EXAMINER

HAMILTON, ISAAC N

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/716,809

Applicant(s)

BRADBURY, PHILIP E.

Examiner

Isaac N. Hamilton

Art Unit

3724

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

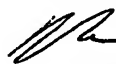
AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant asserts that the terms "cut-off blade" and "ram set" cannot read on the upper die 1 and the lower die 2 having male tools or punches 4 in Dotta. However, the elements in Dotta meet the claim limitations because they act in a manner that is consistent with the broad meanings of cut-off blade and ram. Even though applicant describes two different embodiments, one with a cut-off blade and ram set and one with a punch and die set, the claim language remains broad, and does not distinguish the apparatus over the prior art reference Dotta. Moreover, applicant asserts that it is the Examiner's opinion that the punching device is capable of shearing. However, an Examiner's opinion does not give legal support for the test of capability in the rejection. Instead, one of ordinary skill in the art knows that if a workpiece is less wide than the diameter of a punch, then the workpiece is not only sheared by the adjacent edges of the punch and die, but is completely severed from the rest of the workpiece.


KENNETH E. PETERSON
PRIMARY EXAMINER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Philip E. BRADBURY)	I hereby certify that this paper is
)	being submitted electronically with
U.S. Serial No.	: 10/716,809)	the United States Patent and
)	Trademark Office on this date:
Filed	: 11/19/2003)	
)	
Title	: METHODS AND)	February 5, 2007
	APPARATUS FOR)	
	CUTTING A MOVING)	
	MATERIAL)	
)	
)	<u>/Mark G. Hanley/</u>
Art Unit	: 3724)	Mark G. Hanley
)	Registration No. 44,736
Examiner	: Issac N. Hamilton)	Attorney for Applicant

PRE-APPEAL BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program, the applicant submits this pre-appeal brief accompanying the Pre-Appeal Brief Request for Review. Please consider the following.

I. Status of the Claims

Currently, claims 17, 22-27, and 55-58 are pending in this application. *See Applicant's Response dated November 6, 2006*, pp. 2-4. Claims 17, 22-27, and 55-58 stand rejected, all of which form the subject of this pre-appeal brief.

By way of background, this application was filed on November 19, 2003 with claims 1-54. In the first Office action dated July 21, 2005, the examiner identified six patentably distinct inventions and required restriction of this application to one of those inventions. The applicants filed a response on September 21, 2005, electing claims 17-27 for prosecution and adding claims 55-58.

The examiner issued a second Office action on December 19, 2005, rejecting claims 17-27 and 55-58 under 35 U.S.C. § 102(b) as anticipated by Dotta. The applicant filed a response on June 19, 2006, amending claim 17 to incorporate the limitations of dependent claims 18, 19, and 21, canceling claims 18-21 without prejudice, and traversing the examiner's rejections.

The examiner issued a final Office action on September 5, 2006, rejecting claims 17, 22-27, and 55-58 under 35 U.S.C. § 102(b) as anticipated by Dotta. The applicant filed a response on November 6, 2006, traversing the examiner's rejections without amendment.

The examiner issued an advisory action on December 6, 2006, maintaining the previous rejections. Accordingly, claims 17, 22-27, and 55-58 stand rejected forming the subject of this pre-appeal brief.

II. Issues on Appeal

The issue on appeal is whether Dotta anticipates independent claim 17.

III. Argument

The applicant respectfully submits that Dotta does not anticipate independent claim 17. Independent claim 17 is directed to a rotary press apparatus that includes, *inter alia*, a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. The applicant maintains his position that the art of record fails to teach or suggest first and second cutting tool members comprising a cut-off blade and ram set as recited in claim 17. Dotta teaches an upper die (1) having female tools or matrixes (3) and a lower die (2) having male tools or punches (4). However, Dotta does not teach that the upper and lower dies (1) and (2) have or can have a cut-off blade and ram set. Therefore, Dotta cannot anticipate independent claim 17 because Dotta does not teach each and every element recited in independent claim 17.

The examiner suggests that one of ordinary skill in the art would know the matrixes (3) and punches (4) taught by Dotta are capable of shearing off the ends of thin strips of material due to their widths, and that the cut-off blade and ram set recited in claim 17 describe the matrixes (3) and the punches (4). *See Final Office action dated August 5, 2006*, pp. 2 and 3, ¶ 3 and Advisory Action dated December 6, 2006. The applicant respectfully

submits that the examiner has adopted an improper and unfairly broad meaning for the language cut-off blade and ram set. *See Applicant's Response dated November 6, 2006*, p. 2, ¶ 3 through p. 3, ¶ 1.

Additionally, in the advisory action, the examiner suggests that one of ordinary skill in the art knows that if a workpiece is less wide than the diameter of one of the Dotta punches (4), then the workpiece is not only sheared by the adjacent edges of the punch and die, but is completely severed from the rest of the workpiece. *See Advisory Action dated December 6, 2006*. The examiner's reasoning amounts to taking official notice that one of ordinary skill in the art would know that the punch and die taught by Dotta constitute the cut-off blade and ram set recited in claim 17. The applicant respectfully submits that the examiner's suggestions are not "capable of instant and unquestionable demonstration as being well-known." *See MPEP § 2144.03(A)*. The Dotta punching device includes an array of the punches (4) arranged transversely of a band (N'). *See Dotta, 1:56-60*. The applicant respectfully submits that Dotta teaches feeding a band (N') of material that is wider than any one of the punches (4). Thus, none of the Dotta punches (4) would cut off one portion of the band (N') from another portion of the band (N') as would the cut-off blade recited in claim 17. The applicant respectfully submits that the examiner has not provided the evidence necessary to maintain the rejection based on his assumption that one of ordinary skill in the art would know that one of the Dotta punches (4) constitutes a cut-off blade. *See MPEP § 2144.03(B)*.

In addition, the Dotta punching device also includes a hydrostatic connection (a chamber 16) that permits the array of punches (4) across the band (N') to operate simultaneously on the band (N') to avoid excessive stress thereon and on the entire apparatus. *See Id., 2:58-62*. The principle of operation of the Dotta punching device is to make a plurality of punches simultaneously across the width of the band (N') of material using the plurality of punches (4). One of ordinary skill in the art would not use the Dotta punching device to shear material less wide than the diameter of a punch (4) as suggested by the examiner because doing so would not permit all of the punches (4) to operate simultaneously on a band of material, which is contrary to the principle of operation of the Dotta punching device.

Accordingly, the applicant respectfully submits that Dotta does not anticipate independent claim 17 because Dotta does not teach or suggest a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. Further, one of ordinary skill in the art would not recognize that the punches described by Dotta act in a manner consistent with the meaning of a cut-off blade.

In view of the foregoing, the applicant respectfully submits that the examiner has improperly rejected claims 17, 22-27, and 55-58. Accordingly, the applicant respectfully requests withdrawal of the rejections and respectfully submits that independent claim 17 and all claims dependent thereon are in condition for allowance.

Respectfully submitted,

/Mark G. Hanley/

Hanley, Flight & Zimmerman, LLC
(at customer number 34431)
150 South Wacker Drive, Suite 2100
Chicago, Illinois 60606
312.580.1020

Mark G. Hanley
Reg. No. 44,736
Attorney for Applicant

Dated: **February 5, 2007**



UNITED STATES PATENT AND TRADEMARK OFFICE

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 Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,809	11/19/2003	Philip E. Bradbury	20015/10004	6765

34431 7590 04/11/2007
 HANLEY, FLIGHT & ZIMMERMAN, LLC
 150 S. WACKER DRIVE
 SUITE 2100
 CHICAGO, IL 60606

EXAMINER

HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
-----------	---------------

04/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Application Number 	Application/Control No. 10/716,809 Boyer D. Ashley	Applicant(s)/Patent under Reexamination BRADBURY, PHILIP E. Art Unit 3724
Document Code - AP.PRE.DEC		

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 2/5/07.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 17, 22-27 55-58.

Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Boyer D. Ashley

(2) Tom Barrett

(3) Isaac Hamilton

(4) _____